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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/849,777 | 05/04/2001 | Rodney J. Kempkes | PAT-007 | 9890 |
| 29129 | 7590 | 03/24/2006 | EXAMINER | |
| ROCCO L. ADORNATO C/O WEST CORPORATION 11808 MIRACLE HILLS DR. MAIL STOP: W11-LEGAL OMAHA, NE 68135 | | | POINVIL, FRANTZY | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3628 | |
| DATE MAILED: 03/24/2006 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/849,777 | KEMPKES ET AL. | |
| | Examiner | Art Unit | |
| | Frantzy Poinvil | 3628 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 04 May 2001.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-37 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) _____ is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) 1-37 are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-2, drawn to a method for conducting micropayment transactions between consumers and merchants by transferring a payment to a merchant to settle the micropayment transaction, classified in class 705, subclass 39.
 - II. Claims 3, drawn to a system for conducting micropayment transactions between consumers and merchants by using a clearinghouse adapted to receive data associated with a prepaid instrument from the merchant site and to process the data to settle the micropayment transaction, classified in class 705, subclass 39.
 - III. Claims 4-36, drawn to a business method for conducting micropayment transactions between consumers and merchants by transferring a payment of a third value from a clearinghouse entity to the merchant wherein a second value is greater than the third value thereby generating a second profit to the clearinghouse entity equal to the difference between the second value and the third value, classified in class 705, subclass 39.
 - IV. Claim 37, drawn to a computer implemented user interface supporting execution and settlement of a micropayment transaction conducted between a consumer and a merchant using a prepaid instrument wherein the user interface comprising a first, second, third and fourth field, classified in class 705, subclass 39.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II-IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06).

In the instant case the different inventions are unrelated because as can be seen each of the invention intends to accomplish a different result using different means, steps or functions.

Invention I, does not require functions to be performed by collecting a payment having a second value and transferring a payment of a third value from a clearinghouse as required in Invention II or a dispositioning a proposed micropayment transaction as required in Invention III or a user interface having at least a first field, a second field, a third field and a fourth field as required in invention IV.

Invention II, does not require functions to be performed by decrementing a value parameter associated with a prepaid instrument by an amount corresponding to the value provided by a merchant and transferring a payment to the merchant to settle the micropayment transaction as required in Invention I or dispositioning a proposed micropayment transaction as required in Invention III or a user interface having at least a first field, a second field, a third field and a fourth field as required in invention IV.

Invention III, does not require functions to be performed by decrementing a value parameter associated with a prepaid instrument by an amount corresponding to the value provided by a merchant and transferring a payment to the merchant to settle the micropayment transaction as required in Invention I or collecting a payment having a second value and transferring a payment of a third value from a clearinghouse as required in Invention II or a user

interface having at least a first field, a second field, a third field and a fourth field as required in invention IV.

Invention IV, does not require functions to be performed by decrementing a value parameter associated with a prepaid instrument by an amount corresponding to the value provided by a merchant and transferring a payment to the merchant to settle the micropayment transaction as required in Invention I or collecting a payment having a second value and transferring a payment of a third value from a clearinghouse as required in Invention II or dispositioning a proposed micropayment transaction as required in Invention III.

Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

2. Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the

inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

Conclusion

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frantzy Poinvil whose telephone number is (571) 272-6797. The examiner can normally be reached on Monday-Thursday from 7:00AM to 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sam Sough can be reached on (571) 272-6799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Frantzy Poinvil
Primary Examiner
Art Unit 3628

FP
March 17, 2006